

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	
)	
Thomas J. Reddin, et al.)	
)	Group Art Unit: 3622
Serial No. 09/296,120)	
)	Examiner: Janvier, J.
Filed: April 21, 1999)	
)	
For: METHODS AND SYSTEMS FOR)	
OCCASION BASED LIFESTYLE)	
MARKETING)	

REVISED APPEAL BRIEF

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Board of Patent Appeals & Interferences

Dear Sirs:

Pursuant to 37 C.F.R. §1.192 and MPEP §1206, the Applicant submits this Revised Appeal Brief to the Board of Patent Appeals and Interferences. This brief is in response to the Notice of Unacceptable Appeal Brief mailed on January 18, 2005, April 8, 2005, February 17, 2006, and May 9, 2006. A Notice of Appeal was filed on August 30, 2004. The original Appeal Brief and fee of \$500.00 pursuant to 37 C.F.R. §1.17(c) were submitted on October 27, 2004.

I. REAL PARTY IN INTEREST

This application is assigned to The Coca-Cola Company. An assignment from the individual inventors to The Coca-Cola Company was recorded with the Patent Office at Reel 010077, Frame 0653 on July 6, 1999.

II. RELATED APPEALS AND INTERFERENCES

The Applicant previously appealed this case and filed an appeal brief on May 29, 2003. In response, the Examiner issued a new non-final office action on August 25, 2003. The Applicant is not aware of any other related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1, 2, 4-19, 21-23, 25-28, 30-45, 53, and 59-65, and 67 are pending herein. There is, however, some confusion as to the pending claims. The last Office Action (mailed on June 2, 2004) does not indicate that Claims 4-19 are currently pending. This is in error. All pending claims stand rejected. Claims 44 and 45 also have been objected to. Claims 3, 20, 24, 29, 46-52, and 54-58 have been cancelled. Claim 66 has been withdrawn.

IV. STATUS OF AMENDMENTS

No amendments were filed after the office action of June 2, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention of independent Claim 1 is, for example, directed towards marketing methods that are not dependant upon the price of the product. *See* page 16, lines 24-31. Specifically, Claim 1 concerns a method of promoting the selection of an item 10 by a predetermined type of consumer based upon consumer lifestyle and consumer market data. The method includes the steps of gathering the consumer lifestyle and market data (page 10, line 13 - page 11, line 18), determining one or more representative activities of the consumer based upon the lifestyle data (page

11, lines 20-35), determining one or more representative uses of the item by the consumer during the representative activities based upon the market data (page 12, lines 13-31), and creating demand for the item by the consumer based upon the representative uses of the item by the consumer during the activities through the selection of messaging, brands, packaging, or merchandising (page 15, line 21 - page 16, line 23). *See* Fig. 1. Several examples are shown in Figs. 7-13.

As shown in Fig. 7, for example, the item may be a beverage and the predetermined type of consumer may be a “home category manager”. (Page 11, line 3-18). The consumer lifestyle data may be based on demographic or socioeconomic information (page 10, line 25 – page 11, line 2; page 11, lines 30-34) and the consumer market data may be based upon consumer interviews, transaction data, or otherwise. (Page 12, lines 22 - 31). The representative activity of the consumer may be dinner and the representative use of the item by the consumer during the activity may be as a “meal enhancer”. The step of creating demand by that consumer based upon the use during the activity includes the selection of brands, packaging, merchandising, and messaging as shown in Fig. 7. In other words, the demand is created by selecting the appropriate brands (Cola Brand A), the appropriate packaging (2 liter bottles), the appropriate merchandising (Cola Brand A bundled with frozen foods), and the appropriate messaging (“Complete Your Dinner With Real Refreshment” or “Cola Brand A and Lasagna”). A connection therefore may be made between the item and the use of that item by the particular type of consumer during the representative activity such that the item and the activity drive the sale of the item instead of merely the price of the item. *See* Fig. 8 (“I need Cola Brand A to complete my meal”).

Dependent Claims 5 – 8 concern further limitations as to the predetermined type of consumer. In this case, the consumer is a home category manager. An example in terms of a home category manager with respect to representative activities, representative uses, and creating demand

is shown in Figs. 7 (“Quick Meal Solutions”) and explained in detail at page 19, line 28 through page 22, line 21. This specific combination of solutions (brand, packaging, merchandising, and messaging) is explained in the context of the “when,” the “why,” and the “how”.

Dependent Claims 9 – 11 concern further limitations as to the predetermined type of consumer. In this case, the consumers are blue-collar adults and teens. These claims similarly relate to the “snack time” example found at Fig. 12 and described in the specification at page 26, lines 5 – 27.

Dependent Claims 14 and 15 concern creating demand by messaging that promotes the items as addressing a need associated with one or more uses or by associating the item with one or more activities. This step of creating demand through the selection of messaging that addresses a need associated with one or more uses is described in the specification at page 17, line 27 through page 18, line 2. “For example, the substance of the message **610** may explain how the beverage **20** may solve a consumer’s emotional or functional need or how the beverage **20** serves a purpose.” Various examples also are shown in Fig 7, Fig. 9, Fig. 10, Fig. 11, Fig. 12, and Fig. 13.

Dependent Claims 21 – 23 concern creating demand in the context of packaging. The selection of packaging in the context of the type of consumer or the type of shopping trip is described at page 16, lines 5 – 16. Likewise, each of the figures shows an example on the selection of different types of packaging.

Dependent Claims 25 – 28 concern creating demand by the selection of merchandizing, including the bundling of an item with a different item. The discussion of bundling can be found at page 17, lines 14 – 26. *See* Fig. 8 as well. Bundling creates an association in the consumer’s mind between the respective goods.

Dependent Claims 30 – 35 concern creating demand by the selection of messaging. Messaging is discussed in the specification at page 17, line 27 through page 18, line 28. As discussed, messaging includes both the substance of the message and the meaning of the message. Many different mediums are described from in store greeters to sensory experience such as the sense of smell.

Dependent Claims 36 – 43 concern determining the environment in which an item is offered, including a virtual environment and the nature of specific shopping trips. The various shopping environments are discussed in the specification at page 8, line 30 through page 10, line 11. These environments include the traditional retail outlets as well as virtual outlets based on the Internet and otherwise. The manner in which a consumer selects an item is discussed (the “how”) in detail in the specification at page 13, line 20 through page 15, line 20. Consideration of the “how” focuses on what the consumer may seek to accomplish, on how long the consumer is in the environment, where in that environment the consumer may shop, whether the consumer may purchase the item 10 for immediate or future use, or whether the consumer may purchase the item 10 for individual, family, commercial or group use. Internet examples are found at page 26, line 29 through page 27, line 23 and at Fig. 13.

Dependent Claims 44 and 45 recite a computer-readable medium having computer-executable instructions for performing the steps recited in Claims 1 and 39 respectively. Claims 1 and 39 are described above. The use of such instructions is described in the specification at page 28, lines 24-31 and in the flow charts of Figs. 1, 7, and 9-13.

Independent Claim 53 is similar to independent Claim 1 and is limited to the selection of a beverage by a consumer based upon the consumer lifestyle data and market data. *See, e.g.*, Fig. 7 and the description of Claim 1 above.

Independent Claim 59 recites a method for promoting the use of an item by a predetermined type of consumer. The method includes the steps of receiving consumer lifestyle data corresponding to the representative activities of the predetermined type of consumer (page 10, line 25 – page 11, line 2; page 11, lines 30-34); storing the data (page 28, lines 1-13); receiving the consumer market data corresponding to the representative uses of the item by the predetermined type of consumer (page 12, lines 22-31); storing the data (page 28, lines 1-13); determining a relationship between the data corresponding to the representative activities of the consumer and the data corresponding to the representative uses of the item by the consumer based upon the selection of messaging, brands, packaging, or merchandising (page 28, lines 14-31); and storing the relationship in a marketing database (page 28, line 32 – page 29, lines 17).

Claim 67 is similar to Claim 1, but adds the further limitation of storing the consumer lifestyle and market data in a database and determining the representative activities and uses based upon the stored data. (Page 28, lines 1-13).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 2, 4-19, 21-25, 26-28, 30-45, 53, and 67 stand rejected under 35 U.S.C. § 101.
2. Claims 1, 2, 4-19, 21-23, 25-28, 30-45, and 67 stand rejected under 35 U.S.C. § 112, first paragraph.
3. Claims 1, 2, 4-19, 21-23, 25-28, 30-45, and 67 stand rejected under 35 U.S.C. §112, second paragraph.
4. Claims 1, 2, 4-19, 21-23, 25-28, 30-45, 53, 59 - 65, and 67 stand rejected under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent No. 5, 649,114 to Deaton, et al.

VII. ARGUMENT

A. Prosecution History

This present application originally was filed with 66 claims, with Claims 1, 46, 53, 54, 58, 59, and 66 being independent claims. Independent Claim 1 read as follows:

1. A method for promoting the selection of an item by a predetermined type of consumer, said method comprising the steps of:
 determining one or more representative activities of said predetermined type of consumer;
 determining one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities; and
 creating demand for said item by said predetermined type of consumer based upon said one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities.

The Examiner rejected all claims in an Office Action dated November 6, 2001. Claims 44, 45, and 58 were rejected under 35 U.S.C. §101; Claims 44 and 45 were rejected under 35 U.S.C. §112; and Claims 1-66 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,649,114 to Deaton, et al.

Deaton largely describes a check verification system. The system, however, also provides for target marketing of customers based upon their shopping history. Deaton thus describes the use of point-of-sale coupons and other incentives provided to the customer. *See* Col. 7, lines 31-50. For example, Figs. 15A and B illustrate an infrequent customer program while Figs. 17A and B illustrate a point-of-sale coupon and direct mail coupon system. The coupons are either given at checkout or through the mail. Figs. 18A, B, and C show the use of scan product data. If the system determines that the customer is a frequent shopper but does not purchase coffee, the system may determine that a coffee coupon would be suitable. Col. 68, lines 44-48 and line 64 - col. 69, line 2 (“[t]he present invention differs from the systems disclosed in the above-identified patents because,

among other things, the present system generates coupons based upon the lack of a purchase of a particular item by comparing against stored history for unique customer IDs, rather than because of the purchase of the item.”) On other items, the system considers the shopper’s history in determining when to issue a coupon. Col. 100, lines 47-63.

The Examiner stated that the step of determining one or more representative activities reads on Deaton’s use of customer purchase history data. Likewise, the step of determining one or more representative uses of the item by the customer during one or more representative activities also reads on the use of customer purchase history. Finally, the step of creating demand reads on tracking the products purchased by the consumer.

With respect to Claims 44 and 45, Claim 44 recites “a computer-readable medium having computer-executable instructions for performing the steps recited in Claim 1” while Claim 45 concerns the steps recited in Claim 39. The Examiner stated that these claims must be independent claims.

In a response mailed on December 11, 2001, the Applicant canceled Claim 58 and traversed the remaining rejections. With respect to the rejection under 35 U.S.C. §112, the Applicant pointed out that numerous claims in the form used herein have been allowed and that claims directed to computer executable instructions stored on a computer-readable media are considered to define patentable subject matter. With respect to the rejection under 35 U.S.C. §102(b) to Deaton, et al., the Applicant asserted that the Examiner strained the ordinary definition of the term “representative activities,” *i.e.*, “the when” of the invention. As opposed to the scan data analyzed in Deaton, the activities claimed herein and defined in the specification are those activities of a given consumer during a particular day. In this context, Deaton provides no disclosure relevant to the representative activities, the representative uses, or creating demand depending upon the

activities and uses. For example, Deaton in no way describes using anything while shopping or any other activity.

In an Office Action mailed on April 2, 2002, the Examiner withdrew the rejection under 35 U.S.C. §101; maintained the rejection under 35 U.S.C. §112; and maintained the rejection under 35 U.S.C. §102. The rejection was made final. The Examiner then repeated the first Office Action in full.

The Applicant responded to the Final Office Action in a response mailed on June 3, 2002. The Applicant again stressed that there is no mention in Deaton of determining the uses of any type of product by the consumer during one or more representative activities as is specifically claims herein. Deaton does not promote using anything during, for example, during shopping. In an Advisory Action mailed on June 14, 2002, the Examiner stated that the response raised new arguments. The Applicant thus filed a Request for Continued Examination on July 2, 2002.

In an Office Action mailed on September 20, 2002 the Examiner maintained the §112 and the §102 rejections. The Examiner stated that he did not find persuasive the Applicant's argument that the disclosure of "purchasing data" does not read on the "representative activity of the predetermined type of the consumer" limitation, *i.e.*, the fact that "data" is not a "use". The Examiner instead argued that purchasing data are inherently associated with products or services brought for immediate or subsequent consumption. With respect to the argument that Deaton does not disclose the use of an item during one or more representative activities, the Examiner stated that such limitations also are inherently supported in the art or implicitly disclosed in the reference. The Examiner then repeated the first Office Action in full.

In a response mailed on December 9, 2002, the Applicant argued that the inherency argument is flawed in that the fact that a certain result or characteristic may occur is insufficient to

maintain a rejection. The Applicant thus stressed that Deaton cannot establish (1) determining one or more representative activities of a consumer; (2) determining one or more representative uses of an item by the consumer during the representative activities; and (3) creating demand for the item by the consumer based upon the uses of the item during the representative activities. These limitation simply are not “necessarily present” in Deaton.

In an Office Action mailed on February 22, 2003, the Examiner maintained the section §112 and §102 arguments. With respect to the §112 argument, the Examiner stated that he does not comment on issued patents. The Examiner then repeated the first Office Action in full.

The Applicant thus filed a Notice of Appeal on March 31, 2003 and submitted its Appeal Brief on May 29, 2003. The Examiner issued a non-final Office Action on August 25, 2003. The Examiner maintained the prior rejection under Deaton and added new rejections under §101 and §112, first paragraph. The Applicant responded in an amendment and response dated November 20, 2003. The Applicant amended the claims to address the Examiner’s newfound §112 issues. Specifically, the step of gathering consumer lifestyle and consumer market data was added; the means by which the representative activities and representative uses are determined was added; and the creating demand step was further limited to the selection of messaging, brands, packaging, or merchandising.

In a non-final Office Action mailed on January 27, 2004, the Examiner maintained the previous rejections and added, for the first time, a restriction requirement. The Applicant responded on March 16, 2004 with an election of claims and a partial traverse.

In a further non-final Office Action mailed on June 2, 2004, the Examiner made the restriction of Claim 66 final and repeated the previous rejections. This appeal followed. The original brief was filed on October 27, 2004. In a Notice of Unacceptable Brief, the Examiner stated

that the objections to Claims 44 and 45 and the restriction of Claim 66 do not include appealable subject matter and demanded that those arguments be removed. This revised brief followed.

B. REJECTIONS

1. REJECTION UNDER 35 U.S.C. § 101 - CLAIMS 1, 2, 4-19, 21-25, 26-28, 30-45, 53, AND 67.

The Examiner rejected Claims 1, 2, 4-19 (presumably), 21-25, 26-28, 30-45, 53, and 67 53 under 35 U.S.C. §101 because they pertain to a “manual process” that is not implemented via a computer. Specifically, the Examiner stated as follows:

Claims 1 and 53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. For example, the processor steps disclosed in independent claim 1 pertain to a manual process and therefore, the claims (claims 1-45) do not fall into the technological arts. In other words, the steps or process of **determining one or more representative activities..., determining one or more representative issue ... and creating demand for said same item...**, as recited in claim 1, should be implemented via a device, such as a computer system, a database, a data communication, computer network, the Internet, and so and so forth. Furthermore, the same remarks hold true for claims 46-52, claim 53, and claims 54-57.

June 2004 Office Action at 6.

The Applicant respectfully submits that the rejection under §101 is in error. The focus of a §101 inquiry is whether the process has “practical utility,” *i.e.*, whether the claimed process produces “a useful, concrete, and tangible result.” *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). The Applicant submits that the claims herein easily provide such a “useful, concrete, and tangible” result, *i.e.*, creating a demand for an item through the selection of messaging, brands, packaging, or merchandizing.

Further, the Federal Circuit has made it clear that a method or process claim need not recite any specific structure for carrying out the process. *AT&T Corp. v. Excel Communication, Inc.*,

172 F.3d 1352, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999). Likewise, even the training materials for the Patent Office itself provide that a computer or other type of machine is *not* required to meet the requirements of §101:

Steps carried Out in the Human Mind OK if
Useful, Concrete and Tangible Result
Produced

A method or process remains statutory even if
some or all of the steps therein can be carried
out:

- ✧ in the human mind
- ✧ with the aid of the human mind, or
- ✧ because it may be necessary for one performing the
method or process to think. *In re Musgrave*, 431 F.2d 882,
893; 167 USPQ 280, 289 (CCPA 1970)

The key is that a useful, concrete and tangible result must
be produced.

17

See Millin, Hafiz, Trammell, and Olszewski, 35 U.S.C. §101 TRAINING MATERIALS at 17.

Further, the example given in the “TRAINING MATERIALS” also is persuasive. For example, three claims were considered in the context of §101:

The claims recited:

1. A method comprising the steps of:
 - (a) convening people in a room; and
 - (b) brainstorming to generate a series of steps forming a
scheme for reducing the number of patent applications pending in the
Technology Center.
2. The method of claim 1, further comprising the step of:
 - (c) prioritizing ideas in formulating the scheme.
3. The method of claim 1, further comprising the step of:
 - (c) implementing the step of the scheme.

The TRAINING MATERIALS considered Claim 1 to recite simply manipulating an abstract idea without producing a “useful, concrete and tangible result.” The same was found with Claim 2. Claim 3, however, was found to produce a concrete, tangible, and useful result if the utility

of the claim could be assured. The claim thus met the statutory requirements of 35 U.S.C. §101. As is shown, the use of the computer or other type of machine is not present.

Likewise, in the present case, the specification describes in detail the various ways by which the consumer lifestyle and the consumer market data may be gathered and analyzed with and without computers. Although a computer or a database could play a large role in such steps, the prior art does not require that the claims be so limited. The Applicant thus submits that the claims meet the statutory requirements of 35 U.S.C. §101.

2. 35 U.S.C. § 112, FIRST PARAGRAPH - CLAIMS 1, 2, 4-19, 21-23, 25-28, 30-45, AND 67.

The Examiner rejected Claims 1, 2, 4-19 (presumably), 21-23, 25-28, 30-45, and 67 under 35 U.S.C. §112, first paragraph. The Examiner stated that Claim 1 does not recite “important intervening, critical, or essential steps necessary to the practice of the invention.” The Applicant submits that the rejection is in error. Enablement is generally evaluated by considering the breadth of the disclosure as a whole as opposed to the completeness of a claim. *See* MPEP §2164.01. Moreover, there is no requirement that a claim must be limited to the “preferred materials” in the absence of limiting prior art. MPEP §2164.08(c) states:

Limiting an application to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended.

In this case, the Examiner has not indicated what those “critical” steps may be that are required by the prior art. The Applicant therefore respectfully submits that the claims are enabled and patentable. *See also Aro Manufacturing Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345, 128 USPQ 354 (1961) (there is “no legally recognizable or protected ‘essential’ element

... in a combination patent”); *Special Equipment Co. v. Coe*, 324 U.S. 370 (1945) (the claims need not include every component that is described in the specification.)

3. 35 U.S.C. § 112, SECOND PARAGRAPH - CLAIMS 1, 2, 4-19, 21-23, 25-28, 30-45, AND 67.

The Examiner also rejected Claims 1, 2, 4-19 (presumably), 21-23, 25-28, 30-45, and 67 under 35 U.S.C. §112, second paragraph. The Examiner stated that it is not clear how the process goes from the steps of determining to the final step of creating demand. The Applicant asserts that the rejection is in error. For example, Claim 1 states exactly how the “demand” is created:

creating demand for said item by said predetermined type of consumer based upon said one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities through the selection of messaging, brands, packaging, or merchandising.

The Applicant submits that this language is more than sufficiently distinct in that it states exactly how the demand is created. The gathering steps and the determining steps are tied directly to the demand step despite the fact that there is no requirement that the claimed elements recite a specific interdependency. *See* MPEP §2172.01. Further, the claim specifically states how the demand is created, *i.e.*, through the selection of message, brands, packaging, or merchandising. The Applicant therefore respectfully submits that the claims are distinct and patentable.

4. REJECTION UNDER 35 U.S.C. §102 (B) OVER U.S. PATENT NO. 5, 649,114 TO DEATON, ET AL.

a. CLAIMS 1, 2, 4, 12, 13, 16-19, 44-45, 53, AND 67

As a preliminary note, the Applicant states that the prior art rejection concerning Deaton has not changed in content despite the amendments of November 20, 2003. Specifically, these amendments concerned the use of consumer lifestyle and marketing data and the creation of demand through the selection of messaging, brands, packaging, or merchandising. These limitations

have not been commented on despite the fact that no serious argument can be made that Deaton discloses, for example, the demand step as amended.

As described above, Claim 1 states as follows:

A method for promoting the selection of an item by a predetermined type of consumer based upon consumer lifestyle and consumer market data, said method comprising the steps of:

- gathering the consumer lifestyle and the consumer market data;
- determining one or more representative activities of said predetermined type of consumer based upon the consumer lifestyle data;
- determining one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities based upon the consumer market data; and
- creating demand for said item by said predetermined type of consumer based upon said one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities through the selection of messaging, brands, packaging, or merchandising.

The Applicant respectfully submits that Deaton does not show *any* of the limitations of the claim other than gathering consumer market data. Specifically, Deaton does not show the limitations of gathering the consumer lifestyle data, determining the representative activities of a predetermined type of consumer based upon the consumer lifestyle data, determining the representative uses of an item by the consumer during the activities based upon the consumer market data, or the step of creating demand for the item by the consumer based upon the uses of the item by the consumer during the activities through the selection of messaging, brands, packaging, or merchandising.

CONSUMER LIFESTYLE DATA

Deaton does not show the use of anything that might be considered consumer lifestyle data. At best, Deaton is concerned with extensive use of various types of register data so as to provide coupons and similar discounts. *See Abstract*. This limitation thus is missing from the reference.

REPRESENTATIVE ACTIVITIES

The representative activities of the predetermined type of consumer are determined in the context of the consumer lifestyle data and focus on typical day-to-day activities. For example, the specification describes numerous examples of such activities in the context of a beverage for specific types of consumers: “Quick Meal Solutions” (Fig. 7); “Shop Refreshed” (Fig. 9); “Social Events” (Fig. 10); “Drive Refreshed” (Fig. 11); “Snack Time” (Fig. 12); and “Internet Usage” (Fig. 13). Deaton, however, is completely silent on any type of activities of any type of consumer, other than (perhaps) shopping. Rather, Deaton simply discloses tracking a consumer’s shopping history. *See Abstract.* The Applicant submits that determining what a consumer *buys* is not the same as determining what a consumer *does* on a day-to-day basis. This limitation thus is missing from the reference.

REPRESENTATIVE USES

The representative uses of an item by a consumer during an activity are determined in the context of the consumer market data. For example, the uses of a beverage disclosed herein include: “Treat-Refreshment/Tide-Me-Over” (Fig. 9); “Socializers/Relaxers/Meal Enhancer” (Fig. 10); “Refreshment/Tide-Me-Over/Energizer” (Fig. 12); and “Refreshments/Energizer/Rejuvenation/Meal Enhancer” (Fig. 13). Deaton, however, is completely silent on how a consumer uses any particular item. Further, there is certainly no disclosure of how a consumer uses an item *during* one or more representative activities. Rather, Deaton only discloses tracking a consumer’s shopping history. Again, what a consumer *buys* does not disclose what the consumer *does* with the item. Even more so, what a consumer buys does not disclose what the consumer *does* with the item *during* a particular activity. This limitation thus is missing from the reference.

CREATING DEMAND

The demand for the item by the consumer is created in the context of the determined uses of the item by the consumer during the determined activities through the selection of messaging, brands, packaging, or merchandising. No mention of messaging, brands, packaging, or merchandising, however, is even found in the Deaton (or the Office Action). The reason alone is sufficient to allow the claims.

Even if these limitations were considered in any of the office actions, the Applicant submits that the reference clearly fails to anticipate the claims. In addition to the lack of any disclosure concerning messaging, brands, packaging, or merchandising, Deaton also is silent on creating demand for an item by the consumer based upon the uses of the item *during* one or more activities. Again, Deaton merely provides coupons or other incentives based upon a consumer's shopping history. Deaton thus totally lacks a disclosure of creating demand in the context of the uses of the item during the representative activities. This limitation thus is missing from the reference.

INHERENCY

The Applicant respectfully submits that neither the Examiner nor the Board can assert that Deaton discloses the elements claimed in Claim 1. Rather, this rejection appears to be more of an inherency argument. The crux of the Examiner's argument seems to be that by tracking the consumer's shopping history data, the nature of the use of the items purchased and the nature of the activities during which the items are used is somehow inherent. The Applicant respectfully submits that this conclusion is wrong as a matter of law and, further, still does not anticipate the limitation of creating demand for an item based upon how a consumer uses an item during a particular activity.

An inherency rejection is difficult to maintain. MPEP §2112 states as follows:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art)

...

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In order to be a valid anticipation reference, therefore, the Examiner must show how the limitations of the claim are “necessarily” present in Deaton. At the very least, there can be no debate that there is no “necessary” disclosure in Deaton as to creating demand for an item based upon the uses of the item *during* any type of representative activities. In other word, there is nothing inherent in Deaton as to creating demand by connecting a beverage and driving or a beverage and after school time. The Applicant respectfully submits that the fact a consumer purchases an item proves nothing, inherently or otherwise, as to the uses of that product or the activities of the consumer while using the product or the item. The Applicant therefore asserts that these claims are patentable over Deaton.

b. CLAIMS 5-8

This group of claims concerns further limitations as to the predetermined type of consumer. In this case, the consumer is a home category manager. Deaton is completely silent on the characteristics of a home category manager. The Applicant therefore asserts that these claims are patentable over Deaton.

c. CLAIMS 9-11

This group concerns further limitations as to the predetermined type of consumer. In this case, the consumers are blue-collar adults and teens. Deaton is completely silent on the characteristics of blue-collar adults and teens. The Applicant therefore asserts that these claims are patentable over Deaton.

d. CLAIMS 14 & 15

This group of claims concerns creating demand by messaging that promotes the item as addressing a need associated with one or more uses or associates the item with one or more activities. Deaton is completely silent on such messaging limitations. The Applicant therefore asserts that these claims are patentable over Deaton.

e. CLAIMS 21-23

This group of claims concerns creating demand in the context of packaging. Deaton is silent on creating or selecting packaging. The Applicant therefore asserts that these claims are patentable over Deaton.

f. CLAIMS 25-28

This group of claims concerns creating demand by the selection of merchandising, including bundling the item with a different item. Deaton is silent on such limitations. The Applicant therefore asserts that these claims are patentable over Deaton.

g. CLAIMS 30-35

This group of claims concerns creating demand by the selection of messaging. Deaton is silent on such limitations. The Applicant therefore asserts that these claims are patentable over Deaton.

h. CLAIMS 36-43

This group of claims concerns determining the environment in which an item is offered, including a virtual environment and the nature of specific shopping trips. Deaton is silent on such limitations. The Applicant therefore asserts that these claims are patentable over Deaton.

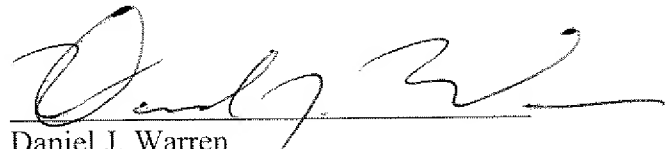
i. CLAIMS 59-65

This group of claims concern receiving and storing the data with respect to the representative activities and the representative uses of an item and then determining a relationship between the activities and the uses by the consumer, particularly in terms of a conversion rate and a profit margin. Again, Deaton only tracks consumer sales history data. Deaton is not interested in any type of relationship between the activities of a consumer and how a consumer uses an item during that activity. The Applicant therefore asserts that these claims are patentable over Deaton.

VIII. CONCLUSION

The Applicant respectfully requests that the Board overturn the rejections of the claims. The Applicant submits that the claims are not anticipated by the disclosure of Deaton, inherently or otherwise. Any questions may be directed to the undersigned at 404.853.8028.

Respectfully submitted, this 19th day of May, 2006.



Daniel J. Warren
Reg. No. 34,272

SUTHERLAND ASBILL & BRENNAN LLP

999 Peachtree Street, N.E.
Atlanta, Georgia 30309-3996
(404) 853-8000
(404) 853-8806 (Facsimile)
daniel.warren@sablaw.com

Docket No.: 25040-0153

APPENDIX A – CLAIMS ON APPEAL

1. A method for promoting the selection of an item by a predetermined type of consumer based upon consumer lifestyle and consumer market data, said method comprising the steps of:

gathering the consumer lifestyle and the consumer market data;

determining one or more representative activities of said predetermined type of consumer based upon the consumer lifestyle data;

determining one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities based upon the consumer market data; and

creating demand for said item by said predetermined type of consumer based upon said one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities through the selection of messaging, brands, packaging, or merchandising.

2. The method of promoting the selection of an item of claim 1, wherein said step of determining one or more representative activities of said predetermined type of consumer comprises analysis of said one or more representative activities within a predetermined length of time.

3. (Cancelled)

4. The method of promoting the selection of an item of claim 1, wherein said step of determining one or more representative activities of said predetermined type of consumer comprises analysis of the consumer lifestyle data.

5. The method of promoting the selection of an item of claim 1, wherein said predetermined type of consumer comprises a home category manager and wherein said one or more representative activities is an event selected from the group consisting of wake up, breakfast, in transit to work, in transit to school, morning break, lunch, afternoon break, after school snack, after school sports, after work workout, dinner, social events, evening snack, and shopping.

6. The method of promoting the selection of an item of claim 5, wherein said item comprises a beverage and wherein said one or more representative uses is a need selected from the group consisting of refreshment, lift, meal enhancer, socializer, re-hydration, relaxer, treat, and a tide-me-over.

7. The method of promoting the selection of an item of claim 6, wherein said step of creating demand for said item through the selection of messaging comprises messaging directed to said home category manager suggesting use of said beverage as said meal enhancer with said dinner.

8. The method of promoting the selection of an item of claim 6, wherein said step of creating demand for said item through the selection of messaging comprises messaging directed to said home category manager suggesting use of said beverage as said refreshment during said shopping.

9. The method of promoting the selection of an item of claim 1, wherein said predetermined type of consumer comprises blue-collar adults and teens and wherein said one or more representative activities is an event selected from the group consisting of after school, afternoon, and after work.

10. The method of promoting the selection of an item of claim 9, wherein said item comprises a beverage and wherein said one or more representative uses is a need selected from the group consisting of refreshment, energy, and a tide-me-over.

11. The method of promoting the selection of an item of claim 10, wherein said step of creating demand for said item through the selection of messaging comprises messaging directed to said blue-collar adults and teens suggesting use of said beverage as said energizer during said afternoon.

12. The method of promoting the selection of an item of claim 1, wherein said consumer market data comprises consumer purchase information.

13. The method of promoting the selection of an item of claim 12, wherein said step of determining one or more representative uses of said item by said predetermined type of consumer during said one or more representative activities comprises analysis of said consumer purchase information.

14. The method of promoting the selection of an item of consumer of claim 1, wherein said step of creating demand through the selection of messaging comprises messaging promoting said item as addressing a need associated with said one or more representative uses.

15. The method of promoting the selection of an item of consumer of claim 1, wherein said step of creating demand through the selection of messaging comprises messaging associating said item with said one or more representative activities.

16. The method of promoting the selection of an item of claim 1, wherein said step of creating demand for said item through the selection of brands comprises selection of one or more brands of said item.

17. The method of promoting the selection of an item of claim 16, wherein said one or more brands comprise predetermined beverage brands.

18. The method of promoting the selection of an item of claim 16, wherein said one or more brands of said item is a liquid selected from the group consisting of coffee; tea; water; fruit, vegetable and juice concentrates; fruit, vegetable and juice beverages; isotonic beverages; non-isotonic beverages; milk and milk byproducts; carbonated soft drinks; and soft drink concentrate.

19. The method of promoting the selection of an item of claim 16, wherein said step of selecting one or more brands comprises selection of one or more food and beverage brands.

20. (Cancelled)

21. The method of promoting the selection of an item of claim 1, wherein said step of selecting packaging comprises selection of a predetermined package.

22. The method of promoting the selection of an item of claim 1, wherein said packaging comprises immediate consumption packaging.

23. The method of promoting the selection of an item of claim 1, wherein said packaging comprises future consumption packaging.

24. (Cancelled)

25. The method of promoting the selection of an item of claim 1, wherein said merchandising comprises bundling the location of said item with a different item.

26. The method of promoting the selection of an item of claim 25, further comprising messaging promoting said bundling of said item with said different item.

27. The method of promoting the selection of an item of claim 1, wherein said merchandising comprises bundling the offering of said item with a different item.

28. The method of promoting the selection of an item of claim 27, further comprising messaging promoting said bundling of said item with said different item.

29. (Cancelled)

30. The method of promoting the selection of an item of claim 1, wherein said messaging comprises media advertising.

31. The method of promoting the selection of an item of claim 30, wherein said messaging is advertising selected from the group consisting of print; radio, television, satellite and cable broadcasting; Internet, e-mail, and computer transmissions; telecommunications; event-based marketing; and direct mail.

32. The method of promoting the selection of an item of claim 1, wherein said messaging comprises in-store displays.

33. The method of promoting the selection of an item of claim 1, wherein said messaging comprises out-doors displays.

34. The method of promoting the selection of an item of claim 1, wherein said messaging comprises the name of said item and said one or more representative uses.

35. The method of promoting the selection of an item of claims 1, wherein said messaging comprises the name of said item and said one or more representative activities.

36. The method of promoting the selection of an item of claim 1, further comprising the step of determining an environment in which said item is offered.

37. The method of promoting the selection of an item of claim 36, wherein said environment comprises a retail environment.

38. The method of promoting the selection of an item of claim 36, wherein said environment comprises a virtual environment.

39. The method of promoting the selection of an item of claim 36, further comprising the step of determining the manner in which said predetermined type of consumer selects said item in said environment.

40. The method of promoting the selection of an item of claim 39, wherein said step of determining the manner in which said predetermined type of consumer selects said item in said environment comprises consumer intercept surveys.

41. The method of promoting the selection of an item of claim 39, wherein said step of determining the manner in which said predetermined type of consumer selects said item in said environment comprises analysis of transactional data.

42. The method of promoting the selection of an item of claim 39, wherein said manner in which said predetermined type of consumer selects said item comprises a purchasing trip selected from the group consisting of quick mission trips, quick meal solution trips, and stock-up trips.

43. The method of promoting the selection of an item of claim 39, wherein said step of creating demand for said item comprises displays located at a location distant from said environment.

44. A computer-readable medium having computer-executable instructions for performing the steps recited in claim 1.

45. A computer-readable medium having computer-executable instructions for performing the steps recited in claim 39.

46. - 52. (Cancelled)

53. A method for promoting the selection of a beverage by a consumer based upon consumer lifestyle data and consumer market data, comprising the steps of:

- gathering the consumer lifestyle data and the consumer market data;
- determining the daily activities of said consumer based upon consumer lifestyle data;
- determining the needs of said consumer for said beverage during said daily activities based upon consumer market data; and

- marketing said beverage in association with said needs of said consumer for said beverage during said daily activities through the selection of messaging, brands, packaging, or merchandising.

54. - 58. (Cancelled)

59. A method for promoting the use of an item by a predetermined type of consumer, said method comprising the steps of:

- receiving consumer lifestyle data corresponding to representative activities of said predetermined type of consumer;

- storing said data corresponding to said representative activities of said predetermined type of consumer in a marketing database;

- receiving consumer market data corresponding to representative uses of said item by said predetermined type of consumer;

- storing said data corresponding to said representative uses of said item by said predetermined type of consumer in said marketing database;

determining a relationship between said data corresponding to said representative activities of said predetermined type of consumer and said data corresponding to said representative uses of said item by said predetermined type of consumer activities based upon the selection of messaging, brands, packaging, or merchandising; and
storing said relationship in said marketing database.

60. The method for promoting the use of an item of claim 59, further comprising the step of creating messaging associating said item with said relationship.

61. The method for promoting the use of an item of claim 60, further comprising the step of storing said messaging in said marketing database.

62. The method for promoting the use of an item of claim 61, further comprising the steps of receiving data corresponding to the conversion rate of said predetermined types of consumers in response to said messaging associating said item with said relationship and storing said data corresponding to said conversion rate of said predetermined types of consumers in said marketing database.

63. The method for promoting the use of an item of claim 62, further comprising the steps of receiving data corresponding to the average transaction amount for said item and storing said data corresponding to said transaction amount in said marketing database.

64. The method for promoting the use of an item of claim 63, further comprising the steps of receiving data corresponding to the average gross profit margin for said item and storing said data corresponding to said average gross profit for said item in said database.

65. The method for promoting the use of an item of claim 64, further comprising the step of determining the value of said messaging based upon said conversion rate, said average transaction amount for said item, and said average gross profit margin for said item.

66. A system for facilitating the use of an item by a predetermined type of consumer comprising:

- a storage device; and
- a processor connected to said storage device,
 - said storage device storing a program for controlling the processor;
 - said storage device storing data representing one or more activities of said predetermined type of consumer;
 - said storage device storing data representing one or more needs of said predetermined type of consumer for said item;
 - said storage device storing data representing one or more marketing solutions promoting the use of said item by said predetermined type of consumer based upon the selection of messaging, brands, packaging, or merchandising; and
 - said processor operative with said program to receive a request for said one or more marketing solutions based upon said one or more activities or said one or more needs of said predetermined type of consumer and to provide said one or more marketing solutions.

67. A method for promoting the selection of an item by a predetermined type of consumer based upon consumer lifestyle and consumer market data, the method comprising:

- gathering the consumer lifestyle and the consumer market data;
- storing the consumer lifestyle and the consumer market data in a database;
- determining one or more representative activities of the predetermined type of consumer based upon the stored consumer lifestyle data;
- determining one or more representative uses of the item by the predetermined type of consumer during the one or more representative activities based upon the stored consumer market data; and
- creating demand for the item by the predetermined type of consumer through the selection of messaging, brands, packaging, or merchandising corresponding to the determined one or more representative uses of the item by the predetermined type of consumer during the determined one or more representative activities.

Evidence Appendix

NONE.

Related Proceedings Appendix

NONE.